

**THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Appellant(s): Antonius EMMERINK  
Appl. No.: 10/088,682  
Conf. No.: 4834  
Filed: July 9, 2002  
Title: COMMUNICATION SYSTEM AND METHOD  
Art Unit: 2616  
Examiner: R. K. Jain  
Docket No.: 118990-024

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**APPELLANTS' APPEAL BRIEF**

Sir:

Appellants submit this Appeal Brief in support of the Notice of Appeal filed on October 5, 2007. This Appeal is taken from the Notice of Panel Decision from Pre-Appeal Brief Review dated December 7, 2007 and the Final Rejection dated July 5, 2007. A Petition for a four (4) Month Extension of Time is hereby attached.

### **I. REAL PARTY IN INTEREST**

The real party in interest for the above-identified patent application on Appeal is Siemens Aktiengesellschaft by virtue of an Assignment dated November 9, 2007 and recorded at reel 020089, frame 0675 in the United States Patent and Trademark Office.

## **II. RELATED APPEALS AND INTERFERENCES**

Appellants' legal representative and the Assignee of the above-identified patent application do not know of any prior or pending appeals, interferences or judicial proceedings which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision with respect to the above-identified Appeal.

### **III. STATUS OF CLAIMS**

Claims 1, 2, 5, 10-15 and 19-21 have been rejected, and claims 3, 4, 6-9 and 16-18 have been objected to in the Office Action. Claims 1-21 are therefore pending in this application. Therefore, claims 1-21 are being appealed in this Brief. A copy of the appealed claims is included in the Claims Appendix.

#### **IV. STATUS OF AMENDMENTS**

A non-final Office Action was mailed January 19, 2207, and Appellants filed a reply on April 17, 2007. Subsequently, a final Office Action was mailed on July 5, 2007, to which Appellants filed a Notice of Appeal, Pre-Appeal Brief Request for Review and Pre-Appeal Brief on October 5, 2007. A Notice of Panel Decision from Pre-Appeal Brief Review was mailed December 7, 2007, from which Appellants filed this Appeal Brief. A copy of the Non-Final Office Action, Final Office Action and Notice of Panel Decision from Pre-Appeal Brief Review are attached as Exhibits A, B and C, respectively, in the Evidence Appendix.

## V. SUMMARY OF CLAIMED SUBJECT MATTER

A summary of the invention by way of reference to the specification and/or figures for each of the independent claims is provided as follows.

Independent claim 1 is directed to a method for setting up and/or clearing down and sustaining a communications link, including providing a communications link between at least two local devices DZ10-DZ40 in a transport network 71030, 72030, 72040, 73020 by local switching centers CS 10-CS40 associated with the local devices; controlling the setup and/or clear-down of the communications link by a central control device via a control network 310, 410, STN; controlling the connection setup and/or clear-down in the transport network using at least two control information items; using a connection information item defining a timeslot connection via a switching matrix representing a first control information item; and providing a protocol information item representing a second control information item for the central control device and/or for the local devices to select communications protocols to be used and useable transport media. See, for example, page 9, line 29 – page 12, line 11 and Fig. 2; and page 15, line 5 – page 21, line 7 and Fig. 5.

Independent claim 10 is directed to an apparatus for setting up and/or clearing down, and sustaining, a communications link, including a transport network 71030, 72030, 72040, 73020 to provide a communications link; a control network 310, 410, STN to control the setup and/or clear-down of the communications link; a first device to control the connection setup and/or clear-down in the transport network via the control network, the device configured with a physical separation from the transport network, which output at least two control information items, and in which the transport network has at least two local devices DZ10, DZ20-40 to output and receive communications data; and a switching center CS to provide a communications link in the transport network, where at least one connection element 71030, 72030 of the communications link is in the form of a connection which uses the Internet Protocol as communications protocol. See, for example, page 9, line 29 – page 12, line 11 and Fig. 2; and page 15, line 5 – page 21, line 7 and Fig. 5.

Although specification citations are given in accordance with C.F.R. 1.192(c), these reference numerals and citations are merely examples of where support may be found in the specification for the terms used in this section of the Brief. There is no intention to suggest in

any way that the terms of the claims are limited to the examples in the specification. As demonstrated by the references numerals and citations, the claims are fully supported by the specification as required by law. However, it is improper under the law to read limitations from the specification into the claims. Pointing out specification support for the claim terminology as is done here to comply with rule 1.192(c) does not in any way limit the scope of the claims to those examples from which they find support. Nor does this exercise provide a mechanism for circumventing the law precluding reading limitations into the claims from the specification. In short, the references numerals and specification citations are not to be construed as claim limitations or in any way used to limit the scope of the claims.

**VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

1. Claims 1, 2, 5, 10-15 and 19-21 have been rejected under 35 USC 103(a) as unpatentable over Shiimoto (US Pat. No. 6,731,628) in view of Rao (US Pat. No. 6,757,823).



## VII. ARGUMENT

### A. LEGAL STANDARDS

#### 1. Obviousness under 35 U.S.C. §103

The Federal Circuit has held that the legal determination of an obviousness rejection under 35 U.S.C. § 103 is:

whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made...The foundational facts for the *prima facie* case of obviousness are: (1) the scope and content of the prior art; (2) the difference between the prior art and the claimed invention; and (3) the level of ordinary skill in the art...Moreover, objective indicia such as commercial success and long felt need are relevant to the determination of obviousness...Thus, each obviousness determination rests on its own facts.

*In re Mayne*, 41 U.S.P.Q. 2d 1451, 1453 (Fed. Cir. 1997).

In making this determination, the Patent Office has the initial burden of proving a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q. 2d 1955, 1956 (Fed. Cir. 1993). This burden may only be overcome “by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings.” *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). “If the examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the Appellant is entitled to grant of the patent.” *In re Oetiker*, 24 U.S.P.Q. 2d 1443, 1444 (Fed. Cir. 1992).

Moreover, the Patent Office must provide explicit reasons why the claimed invention is obvious in view of the prior art. The Supreme Court has emphasized that when formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed. *KSR v. Teleflex*, 127 S. Ct. 1727 (2007).

Of course, references must be considered as a whole and those portions teaching against or away from the claimed invention must be considered. *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve Inc.*, 796 F.2d 443 (Fed. Cir. 1986). “A prior art reference may be considered to teach away when a person of ordinary skill, upon reading the reference would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the

path that was taken by the Appellant.” *Monarch Knitting Machinery Corp. v. Fukuhara Industrial Trading Co., Ltd.*, 139 F.3d 1009 (Fed. Cir. 1998), quoting, *In re Gurley*, 27 F.3d 551 (Fed. Cir. 1994).

B. THE CLAIMED INVENTION

The invention is directed to a system and method for actuating and operating a heterogeneous transport network which includes connection elements, such as ATM and Ethernet connections, by controlling a TDM-based switching system. In the area of transport networks, gateways and routers are actuated by a central control device for the purposes of setting up and clearing down a connection. Information relating to the accessibility of specific communications subscribers by a communication medium and communications protocol is either stored in the area of a central control mechanism, or is available locally in the area of local access devices for subscriber terminals.

C. The rejection to claims 1, 2, 5, 10-15 and 19-21 under 35 USC 103 as unpatentable over Shiimoto (US Pat. No. 6,731,628) in view of Rao (US Pat. No. 6,757,823) should be reversed since the Examiner has failed to establish a *prima facie* case of Obviousness.

With respect to claim 1, for example, the Examiner asserts that Shiimoto teaches all of the claimed features except communications system setup and/or disconnect of communications link. The Examiner asserts that Rao teaches this feature.

Applicants respectfully submit that Rao fails to teach or suggest that which the Examiner asserts and that even if Rao did teach that which the Examiner asserts, one of ordinary skill in the art would not have been motivated to have modified Shiimoto in view of Rao to create the claimed invention.

Claim 1 requires, for example, controlling the setup and/or clear-down of the communications link by a central control device via a control network. Rao fails to disclose this feature. Rather, Rao teaches an H.323 gateway for network interfacing between an IP packet data network and a circuit switched network (col. 2, lines 47-52). Here, Rao explains that the gateway is a node that connects two otherwise incompatible networks (col. 2, lines 53-54). The gateway of Rao, therefore, does not correspond to the claimed central control device.

Even if we assume *arguendo* that Rao teaches the alleged feature, Applicants submit that one of ordinary skill in the art would not have been motivated to modify Shiomoto in view of Rao. Rao teaches enhanced security for telephony calls by encrypting communications. These setup procedures for secure communications require steps beyond simple setup steps, leading to overhead.

Shiomoto, on the other hand, teaches away from creating overhead. As discussed specifically in column 1, lines 38-50, Shiomoto states that in data communications based on an IP architecture, no dedicated connection is required and data can be transferred by means of an extremely simple procedure. However, under this scheme delay is longer than in an STM-based circuit-switched network, and some overhead is necessary. Shiomoto is contrasting existing systems with the type of system the STM network used Shiomoto, which does not require much overhead. Furthermore, Shiomoto compares the Shiomoto system with an ATM, stating in that an ATM-based data transfers, 5 bytes of a 53 byte cell are overhead, embodiments of the present invention [the Shiomoto systems] do not require such overhead. (See column 7, lines 47-50) And even further, Shiomoto specifically states “The present invention can thus provide STM connections dynamically, on the basis of an STM trunk network based on the UP addresses used in data communications. This has previously only been possible in the case of simple leased lines. It follows that this invention can be used to implement a circuit-switched network in which there is little delay or overhead.” (See column 7, lines 53-59) (emphasis added).

A *prima facie* case of obviousness can be rebutted if the applicant...can show that the art in any material respect ‘taught away’ from the claimed invention...A reference may be said to teach away when a person of ordinary skill, upon reading the reference...would be led in a direction divergent from the path that was taken by the application.” *In re Haruna*, 249 F.3d 1327, 1335, 58 USPQ2d 1517 (Fed. Cir. 2001). Since, Shiomoto makes it abundantly clear that overhead is a drawback and undesirable, it teaches away from combining a system, such as Rao, that actually causes overhead. Thus, one of ordinary skill in the art would not have been motivated to modify Shiomoto in view of Rao to create the claimed invention.

Additionally, the Action fails to provide proper motivation for combining these references. The Examiner merely states that it would have been desirable to have incorporated the teaches of Rao with Shiomoto, so as to provide a simplified and secure call setup and tear down procedure for voice and data communications amongst different devices with an IP

telephony network. Although, using the method taught in Rao might make a system secure, Applicants fail to see how encrypting communications (as taught in Rao) can make them simpler. Encryption by definition would make communications more complex. Furthermore, Applicant fails to see the motivation for making Shiomoto encrypted and thus secure, especially in light of the fact that Shiomoto teaches away from delay and overhead.

Thus, the Examiner has failed to set forth a *prima facie* case of obviousness and this rejection should be withdrawn.

Claim 10 is allowable for the same reasons claim 1 is allowable. The remaining claims are allowable at least due to their respective dependencies. Applicants request that this rejection be withdrawn.

D. Allowable Claims

Claims 3, 4, 6-9 and 16-18 are allowable.

### VIII. CONCLUSION

Appellants respectfully submit that the Examiner has failed to establish that the applied reference discloses each and every limitation of the claimed invention under 35 U.S.C. §103 with respect to the rejection of Claims 1, 2, 5, 10-15 and 19-21. Claims 3, 4, 6-9 and 16-18 are allowable. Accordingly, Appellants respectfully submit that the anticipation rejection is erroneous in law and in fact and should therefore be reversed by this Board.

The Director is authorized to charge any additional fees which may be required, or to credit any overpayment to Deposit Account No. 02-1818. If such a withdrawal is made, please indicate the Attorney Docket No. 118990-024 on the account statement.

Respectfully submitted,

BELL, BOYD & LLOYD LLP

BY 

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Dated: May 7, 2008

## CLAIMS APPENDIX

### PENDING CLAIMS ON APPEAL OF U.S. PATENT APPLICATION SERIAL NO. 10/088,682

1. A method for setting up and/or clearing down and sustaining a communications link, comprising:
  - providing a communications link between at least two local devices in a transport network by local switching centers associated with the local devices;
  - controlling the setup and/or clear-down of the communications link by a central control device via a control network;
  - controlling the connection setup and/or clear-down in the transport network using at least two control information items;
  - using a connection information item defining a timeslot connection via a switching matrix representing a first control information item; and
  - providing a protocol information item representing a second control information item for the central control device and/or for the local devices to select communications protocols to be used and useable transport media.
2. The method as claimed in claim 1, in which the control information item is complemented by a media information item which relates to the transport network and identifies at least one transport network medium for the communications link.
3. The method as claimed in claim 1, wherein the communications link comprises at least two connection elements in the transport network, where each connection element uses at least one respective communications protocol whose layer structure differs in at least one layer and in which the control information item is complemented by an information item which identifies a conversion apparatus for the various communications protocols.
4. The method as claimed in claim 1, wherein the communications link comprises at least two connection elements in the transport network, where each connection element uses at least one respective communications protocol whose layer structure differs in at least one layer

and in which the control information item is complemented by an information item which identifies a media access device for a respective communication medium.

5. The method as claimed in claim 1, in which an information item is provided centrally to complement the control information item in the area of the central control device.

6. The method as claimed in claims 4, in which an information item is provided locally to complement the control information item and is ascertained at least once by the central control device in the course of the handling of a communications link.

7. The method as claimed in claim 3, in which connection elements between local devices in the transport network use the Internet Protocol for transmission, and in which connection control is effected by assigning to an IP address one PCM data-stream subscriber line and a local device.

8. The method as claimed in claim 1, in which control information checks whether a connection setup via the transport network is necessary, and provides the connection elsewhere.

9. The method as claimed in claim 8, in which the control information item used is at least one address for a local device, and if the communications link relates to communications terminals which are connected to the same local device, a connection is set up without the communications data being converted on a transport-network-specific basis.

10. An apparatus for setting up and/or clearing down, and sustaining, a communications link, comprising:

- a transport network to provide a communications link;
- a control network to control the setup and/or clear-down of the communications link;
- a first device to control the connection setup and/or clear-down in the transport network via the control network, the device configured with a physical separation from the transport network, which output at least two control information items,

and in which the transport network has at least two local devices to output and receive communications data; and

a switching center to provide a communications link in the transport network, where at least one connection element of the communications link is in the form of a connection which uses the Internet Protocol as communications protocol.

11. The apparatus as claimed in claim 10, in which the control network has a central device and is operatively connected to a second device to provide transport-network-specific protocol information and/or transport network media information.

12. The apparatus as claimed in claim 11, in which the second device is arranged centrally in the area of the first device.

13. The apparatus as claimed in claim 11, in which the second device is arranged locally in the area of the local device.

14. The apparatus as claimed in claim 10, in which a local device has at least one conversion device in the form of a gateway to convert a TDM protocol into an IP protocol.

15. The apparatus as claimed in claim 10, in which the local device has at least one network access device to an Ethernet, in the form of a transceiver.

16. The apparatus as claimed in claim 10, in which a local device has at least a first device to address evaluation of addresses for local devices which output a first signal when a communications link relates to a single central device.

17. The apparatus as claimed in claim 16, in which the first signal is output to a device to access timeslots in the TDM data stream from the local device, and the local device shorts the connection in the TDM data stream in response to the reception of the signal.



18. The apparatus as claimed in claim 17, in which the connection is shorted by interchanging the reading and writing directions.

19. The apparatus as claimed in claim 10, in which the local device is in the form of an integrated communications terminal.

20. The apparatus as claimed in claim 19, in which the integrated communications terminal is in the form of a telephone.

21. The apparatus as claimed in claim 19, in which the communications terminal is in the form of a personal computer.

**RELATED PROCEEDINGS APPENDIX**

None.

**EVIDENCE APPENDIX**

EXHIBIT A: Final Office Action dated July 5, 2007

EXHIBIT B: Notice of Panel Decision from Pre-Appeal Brief Review dated December 7, 2007



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,682	07/09/2002	Antonius Emmerink	449122025400	4834

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EXAMINER	
JAIN, RAJ K	

ART UNIT	PAPER NUMBER
2616	

MAIL DATE	DELIVERY MODE
07/05/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

RECEIVED

JUL 06 2007

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DOCKETED Fri Rep + Ntc Appeals  
REMINDER: 9-5-07  
DUE DATE: 10-3-07  
FINAL DUE DATE: 1-5-08 *off*

# Office Action Summary

Application No.

10/088,682

Applicant(s)

EMMERINK ET AL.

Examiner

Raj K. Jain

Art Unit

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 4/17/07.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,10-15 and 19-21 is/are rejected.
- 7) ☒ Claim(s) 3,4,6-9 and 16-18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 July 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 5, 10-15 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiimoto et al (US006731628B1) in view of Rao et al (US006757823B1).

Regarding claims 1 and 10, Shiimoto discloses providing a communications link (Fig. 1) between at least two local devices TE-1, TE-2 in a transport network by local switching (LS) centers associated with the local devices (TE);

using a connection information item defining a timeslot connection (see abstract, col 2 lines 10-20, 40-50, timeslot information is created to define the routing of packets which is the information item for connection of the link.) via a switching matrix representing a first control information item; and providing a protocol information item representing a second control information item for the central control device and/or for the local devices to select communications protocols to be used and useable transport media (The header of the packet contains IP protocol information that contains the packet routing information, see claim 1.)

Shiimoto fails to disclose communications system setup and/or disconnect of communications link.

Rao discloses a method of providing secure signaling connections for packet data network telephony calls (see Fig. 3 and col 1 line 65 – col 2 line 5. Call setup is performed between H.323 devices such as phones and protocol conversion control performed via the H.323 gateways (Fig. 1). Rao discloses a simplified and secure call setup and tear down procedure for voice and data communications amongst different devices within an IP telephony network.

Thus it would have been obvious at the time the invention was made to incorporate the teachings of Rao within Shiimoto so as to provide a simplified and secure call setup and tear down procedure for voice and data communications amongst different devices within an IP telephony network.

Regarding claims 2 and 11, Shiimoto discloses media information via the routing tables (see col 3 lines 40-50.) used by the local and transit switches to route packets from source to destination.

Regarding claim 5, Shiimoto discloses the information item (see abstract) as the timeslot connection information is provided to the LS and TS switches accordingly.

Regarding claims 12 and 13, Shiimoto discloses devices may be arranged centrally and/or locally in the area of the first device (see Fig. 1).

Regarding claims 14, Rao discloses conversion devices (Gateways see Fig. 1).

Regarding claims 15, Shiimoto discloses a general circuit switched network. The use of an Ethernet connection is inherent to the network as TE devices are shown in Fig. 1.

Regarding claims 19-21, Shiimoto and Rao disclose an integrated communications IP telephony system with a PC (Fig. 1 of Shiimoto) or a telephone (Fig. 1 of Rao) accordingly.

#### ***Allowable Subject Matter***

Claims 3, 4, 6-9, 16-18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Response to Arguments***

Applicant's arguments filed 17 April 2007 have been fully considered but they are not persuasive.

With respect to claim 1, applicant contends the cited references fail to teach "communications system setup and/or disconnect of communications link".

The examiner respectfully disagrees, while Shiimoto does not disclose this limitation, Rao cures this deficiency. Rao discloses a method of providing secure signaling connections for packet data network telephony calls (see Fig. 3 and col 1 line 65 – col 2 line 5. Call setup is performed between H.323 devices such as phones and protocol conversion control performed via the H.323 gateways (Fig. 1). *H.323 is an ITU standard defining a set of call control, channel setup, and codec specifications for transmitting real-time audio and video over packet data networks, (col 2 lines 58-61)* emphasis added. The H.323 gateway serves as the "device" by which the "controlling"



functionality of the H.323 protocol is achieved. Thus Shimoto in combination with Rao clearly and explicitly disclose the cited limitation of applicant's claims and therefore the rejection for claim 1 is sustained.

With respect to motivation for combining, Examiner believes the motivation to be proper and therefore disagrees with the applicant. According to MPEP 2144 [R-5] here in part;

*"The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant (emphasis added)."*

Thus again the examiner fully believes that the reasons for combining are valid since it improves network efficiency and therefore the rejection is sustained.

Furthermore, applicant contends in the page 7 of the "Remarks" here in part:

".....applicants submit that one of ordinary skill in the art would not have been motivated to modify Shiimoto in view of Rao because Rao teaches a setup method for secure communications. This requires steps beyond simple setup steps, which leads to overhead. Shiimoto itself teaches that such overhead is undesirable (see Background of the Invention)."

The Examiner failed to find where Shiimoto discloses "overhead is undesirable" in the (Background of the Invention). Thus applicant's contention is moot.

Once again, the rejection under 35 U.S.C. 103(a) as being unpatentable over Shiimoto et al in view of Rao et al fully discloses all limitations of applicant's claim 1 and therefore the rejection is sustained.

Claim 10 for same reasons as claim 1 is also not patentable. The remaining claims are either properly rejected due to their respective dependencies or stated as allowable.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raj K. Jain whose telephone number is 571-272-3145. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chi Pham can be reached on 571-272-3179. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

Art Unit: 2616

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

***Raj K. Jain***  
***/Raj K. Jain/***

***Art Unit 2616***

July 2, 2007



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,682	07/09/2002	Antonius Emmerink	449122025400	4834

25227 7590 12/07/2007  
MORRISON & FOERSTER LLP  
1650 TYSONS BOULEVARD  
SUITE 400  
MCLEAN, VA 22102

EXAMINER
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JAIN, RAJ K

ART UNIT	PAPER NUMBER
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2616

MAIL DATE	DELIVERY MODE
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12/07/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

RECEIVED

DEC 10 2007

Morrison & Foerster LLP

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DEC 10 2007

ATTY:


DOCKET #

PAY/KCS

118490-024

TRANSFERRED

02-31-07

<b>Application Number</b> 	<b>Application/Control No.</b> 10/088,682  Chi H. Pham	<b>Applicant(s)/Patent under Reexamination</b> EMMERINK ET AL. <b>Art Unit</b> 2616
<b>Document Code - AP.PRE.DEC</b>		

## Notice of Panel Decision from Pre-Appeal Brief Review



This is in response to the Pre-Appeal Brief Request for Review filed 10/05/07.

1. ☐ **Improper Request** – The Request is improper and a conference will not be held for the following reason(s):

- ☐ The Notice of Appeal has not been filed concurrent with the Pre-Appeal Brief Request.
- ☐ The request does not include reasons why a review is appropriate.
- ☐ A proposed amendment is included with the Pre-Appeal Brief request.
- ☐ Other: \_\_\_\_\_

The time period for filing a response continues to run from the receipt date of the Notice of Appeal or from the mail date of the last Office communication, if no Notice of Appeal has been received.

2. ☒ **Proceed to Board of Patent Appeals and Interferences** – A Pre-Appeal Brief conference has been held. The application remains under appeal because there is at least one actual issue for appeal. Applicant is required to submit an appeal brief in accordance with 37 CFR 41.37. The time period for filing an appeal brief will be reset to be one month from mailing this decision, or the balance of the two-month time period running from the receipt of the notice of appeal, whichever is greater. Further, the time period for filing of the appeal brief is extendible under 37 CFR 1.136 based upon the mail date of this decision or the receipt date of the notice of appeal, as applicable.

☒ The panel has determined the status of the claim(s) is as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: 3, 4, 6-9, 16-18.

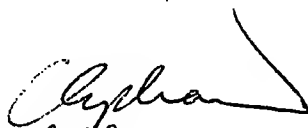
Claim(s) rejected: 1, 2, 5, 10-15, 19-21.


Claim(s) withdrawn from consideration: \_\_\_\_\_

3. ☐ **Allowable application** – A conference has been held. The rejection is withdrawn and a Notice of Allowance will be mailed. Prosecution on the merits remains closed. No further action is required by applicant at this time.

4. ☐ **Reopen Prosecution** – A conference has been held. The rejection is withdrawn and a new Office action will be mailed. No further action is required by applicant at this time.

All participants:

(1) Chi H. Pham 

(3) Raj Jain 

(2) Wellington Chin 

(4) \_\_\_\_\_